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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,529	01/25/2000	Thomas K. Roslak	A31598-A-A-072797.0121	7245

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EXAMINER

NGUYEN, CUONG H

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/490,529

Applicant(s)
Roslak et al.

Examiner
Cuong H. Nguyen

Art Unit
3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/05/2003 (the amendment & terminal disclaimers).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 23-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 14, 18, 19, and 23-27 is/are rejected.
- 7) ☒ Claim(s) 12 and 15-17 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

1. This Office Action is the answer to the amendment received on 3/05/2003, which paper has been placed of record.
2. Claims 1-19, and 23-27 are elected for prosecution in this application.

Response

3. Applicants' arguments received on 3/05/2003 have been fully considered but they are not persuasive with previous cited references for 35 U.S.C. 103(a) rejections. And applicants' amendment by adding a term of "portable" do not make claimed subject matter not obvious with one of ordinary skill in the art. The examiner telephone the applicants' representative on 5/16/2003 to clarify this obviousness but the applicants' representative was not available.

The examiner submits that Wren (US Pat. 6,055,514 – filed 6/21/1996 and published on 4/25/2000) suggests claim 19 's limitation.

The examiner submits that these following US Pat. suggest : scanning items to be purchased, collecting a scanned list, purchasing items at check-out point (limitations in claim 23):

- Sehr; Richard P., US Pat. 6,325,292 – published on 4/12/2001, suggests about methods of utilizing collector cards.
- Becker; Robert J. et al., US Pat. 6,168,079 – published on 1/02/2001, suggest about a customer information terminal system with a docking member for a data collection device.
- Hollenberg; Dennis D., US Pat. 6,091,956 – published on 7/18/2000, suggests about a situation information system.

- Beach; Robert et al., US Pat. 6,084,528 – published on 7/04/2000, suggest about an Intranet scanning terminal system.
- Lester; Douglas D. et al., US Pat. 6,021,392 – published on 2/01/2000, suggest about a system and a method for drug management.
- Tracy; William X. et al., US Pat. 5,979,757 – published on 11/09/1999, suggest about a method for presenting item information using a portable data terminal.
- Mazzamuto; Anthony et al., US Pat. 5,665,953 – published on 9/09/1997, suggest about a self-contained personal data collector for redeeming coupons.
- Ruppert; Jonathan Paul et al., US Pat. 5,640,002 – published on 6/17/1997, suggest about portable RF ID tag and barcode reader.
- Trotta, Jr.; Frank P , US Pat. 5,595,264 – published on 1/21/1997, suggests about methods for automated shopping.
- Ruppert; Jonathan P., US Pat. 5,424,524 – published on 6/13/1995, suggests about a personal scanner/computer for displaying shopping lists and scanning barcodes to aid shoppers.
- Call; James, US Pat. 5,023,929 – published on 6/11/1991, suggests about an audio frequency based market survey method.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

4. Claims 1, 7-8, 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al. (US Pat. 6,236,974).

A. Re. To claim 1: **Kolawa** et al. suggest an analogous computer system and analogous remote terminals over a communication network, comprising:

- a terminal/computer system, see **Kolawa** et al., "These three systems are store servers, a remote control system, and information servers.";
- a remotely located terminal, **Kolawa** et al. obviously disclose a remotely terminal by showing: "For instance, the preference vectors may be stored at an offside server along with a unique ID. When access to a particular preference vector is desired,"; and
- a centrally server/controller for communicating with said terminal/computer system and said remote terminal via a network, **Kolawa** et al. obviously disclose a central server by showing: "In general, store servers are implemented as computers that are connected to the network. The request for the sale of products is received through the connection. The request is then analyzed and compared to the database of available products in the store. The products selected are then assembled and prepared for delivery. It is not important how the store server interacts with the store computer system. It can interact through the use of store employees who key-in products to sell or it can

interact by having a direct connection to the store computer. The purchased products are then added to the list of products which a delivery service will either deliver to the home or that will be stored waiting for someone to pick up”.

Although **Kolawa et al.**, do not expressly disclose exactly claimed languages, but they suggest an analogous system with components that creating a picture of an environment that is claimed; the examiner submits that claiming “a portable computer” is still obvious with artisan since laptop computers existed before this pending invention and using a computer or a laptop computer would not effect the function of the claim subject matter; actually a computer or laptop computer are interchangeable for what they can perform. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the configuration in the system of **Kolawa et al.**, because **Kolawa et al.**’s system would provide all interactive communications exactly as claimed.

B. Re. To claim 7: The examiner submits that any computer with a LUT and a calculating function storing in its hard drive & its microprocessor would do conversions as claimed.

C. Re. To claim 8: The examiner submits that it is well-known of computer using modems for communication with secured lines; and silent/invisible communications are options that users would turn ON/OFF easily depending on users’ desires.

D. Re. To claim 13: The examiner submits that it is well-known of a computer coupled to a camera for monitoring purposes.

E. Re. To claim 14: The examiner submits that it is well-known of a computer's features of local/remote control/communications, e.g. a master computer/controller on a network that can control slave computers for communicating voice data, ordering goods remotely via Internet.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al. (US Pat. 6,236,974), in view of the Official Notice.

Kolawa et al. suggest a system as in claim 1, wherein said shopping terminal comprises means for finger identification.

The Official Notice is taken here that using finger-print for identification has been well-known in business transaction (e.g., Wren, US Pat. 6,055,514 – filed 6/21/1996 and published on 4/25/2000).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the configuration in the system of **Kolawa et al.**, with the **Official Notice** taken above because artisans would recognize this very secure feature being successful in various fields.

6. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al. (US Pat. 6,236,974), in view of the Official Notices.

A. Re. To claim 23: In addition to Kolawa et al. suggestions, the Official Notices are taken that **UPS** and **amazon.com Inc.** business practice comprising:

- associating a terminal with a network and a customer;
- scanning a purchased item using the terminal;
- returning the terminal to the terminal receptacle;

- collecting a receipt corresponding to a scanned item; and
- distributing/purchasing a scanned item at a check-out station.

B. Re. To claim 24: In addition to Kolawa et al. suggestions, the Official Notice is also taken that amazon.com business practices having these steps for both operators and customers:

- checking-in by a customer;
- authorizing a terminal for use; and
- obtaining the authorized terminal from its location.

C. Re. To claim 25: In addition to Kolawa et al. suggestions, the Official Notice is also taken that a step of freely associating the terminal with a network is known (e.g., customer orders from amazon.com using a shopping list).

D. Re. To claim 26: In addition to Kolawa et al. suggestions, the Official Notice are also taken that these steps are known in practice:

- generating a list from a remote location (e.g., customer orders from amazon.com using a shopping list);
- forwarding said list to a controller (e.g., customer orders from amazon.com using a shopping list);
- generating a picking list at the controller corresponding to items identified in the shopping list (e.g., amazon.com business practice);
and
- collecting the items identified in the picking list for check-out/delivery (e.g., amazon.com business practice).

E. Re. To claim 27: In addition to Kolawa et al. suggestions, the Official Notices are also taken that these steps are well-known in practice:

- generating a (shopping) list (e.g., customer orders from amazon.com using a shopping list);
- forwarding said list to a server/controller (e.g., amazon.com business practice);
- generating a picking list at the server/controller (corresponding to items identified in a shopping list) this step is a MUST in order to do business;
- assigning a barcode to the picking list (e.g., this step has been done for UPS package);
- printing a label showing the picking list ID barcode (e.g., this step has been done for UPS package);
- scanning items corresponding to said picking list (e.g., amazon.com business practice); &
- collecting scanned items for check-out (this step is a MUST in order to do business; e.g., amazon.com business practice).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to suggest above steps with the implementation of above Official Notices in Kolawa et al. suggestions, because artisans would recognize this procedure is organized and in good orders for being successful in various practices.

Claim Objections

7. Claims **12, 15-17** are objected because they incorporate their parent 's claim said above defecting limitation by dependencies. They are allowable if written in independent forms incorporating all independent claim's limitations.

Conclusion

8. Claims **1-11, 13-14, 18-19, 23-27** are not patentable. Claims **12, 15-17** are objected.

9. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. A shortened statutory period for reply to this Final Action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this Final Action.

11. These following references are also considered combinable to meet claimed limitations:

- **Tracy** et al. (US Pat 5,979,757 filed 12/20/1996. class 705/27), Method and system for presenting item information using a portable data terminal, wherein a

portable shopping system is utilized. The system is provided with improved data presentation system for presenting customer desired data on a portable terminal. The portable terminal includes audio as well as video presentation means which are used to provide customer specific marketing files to promote the sale of identified items.

- **Stevens**, (US Pat. 6,327,570 – 12/2001, filed 11/06/1998, class 705/7,10),
Personal business service system and method, about system and method of computerizing companies with customized individual addressable electronic direct marketing, self-service automation, and customer care support. The system contains a private network connecting product companies, manufacturers, stores, educational institutions, travel companies, medical providers, financial institutions, and many others to a specified individual customer. The connection is made to a personal agent device carried or worn by a participating consumer that contains local processing means with an interactive display, security features, optional camera, and wireless communications with the private network. Communications microchips can be placed on products that communicate product information upon interrogation with the personal agent. The invention also includes business professional units in communication with the private network and in-store local wireless communication between personal agents and the business professional unit; docking stations for personal agent devices are also suggested.

- **Oosterveen et al.**, (US Pat. 5,468,942 – 11/21/1995, class. 235/383),
Dispensing device for hand scanners accessible from two sides, wherein said

device is used in a self-service store adapted for use of a self-scanning system, said device comprises an identification device for customers and accommodating elements for hand scanners.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong H. Nguyen whose telephone number is 703-305-4553. The examiner can normally be reached on Mon.-Fri. from 7:15 AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344. Any response to this action should be mailed to:

Amendments

***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to: (703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

703-746-5572 (RightFax) Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Cuong H. Nguyen
Primary Examiner
May 17, 2003